



S/N 09/751,610

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: William A. Harris
Serial No.: 09/751,610
Filed: December 29, 2000
Title: PRECISION PHASE GENERATOR

Examiner: Cassandra Cox
Group Art Unit: 2816
Docket: H16-26054

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

The applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a Notice of Appeal.

The review is requested for the reason(s) stated below:

Claims 1-3, 20-24, 26-29, 31-37, 39-45 and 47-48 were rejected under 35 USC §103(a) as being unpatentable over Li (U.S. Patent No. 5,058,132) in view of Epstein (U.S. Patent No. 4,093,870) and Mano (Computer Engineering Hardware Design, 1988, pgs.130-132). The applicant respectfully traverses.

Each of the independent claims 1, 20, 32, and 40 recite, among other elements, a Johnson counter comprising an input JK flip-flop, an output JK flip-flop, and a plurality of middle JK flip-flops. The remaining claims are variously dependent on, and recite further features with respect to, the independent claims 1, 20, 32, and 40.

The MPEP requires a suggestion and a reasonable expectation of success for a rejection under 35 USC §103:

“To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.”¹

A Federal Circuit opinion states that the suggestion or motivation to combine references

and the reasonable expectation of success must both be found in the prior art.²

The Federal Circuit has emphasized the need for the PTO to furnish evidence in support of claim rejections under 35 USC § 103 in *In re Lee*:

“When patentability turns on the question of obviousness, the search for and analysis of the prior art includes evidence relevant to the finding of whether there is a teaching, motivation, or suggestion to select and combine the references relied on as evidence of obviousness.....The factual inquiry whether to combine references must be thorough and searching....It must be based on objective evidence of record.”³

The Federal Circuit has also indicated that the suggestion to select and combine references must be “clear and particular”:

“[T]he best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references.....the showing must be clear and particular.”⁴

Li relates to a clock distribution system and shows a circuit called a Johnson counter 114 in Figure 2. A prior Office Action stated that “Li does not disclose the particular design of the Johnson counter.”⁵ Epstein relates to an apparatus for testing reflexes and shows a circuit called a Johnson counter 54 in Figure 4. Epstein’s Johnson counter 54 has only three JK flip-flops.

Mano describes different types of flip-flops, and contrasts the operation of each. Specifically, Mano describes JK flip-flops, D flip-flops, SR flip-flops, and T flip-flops.⁶ Mano does not discuss Johnson counters, or the relative merits of different Johnson counters.

Neither Li nor Epstein show a Johnson counter comprising an input JK flip-flop, an output JK flip-flop, and a plurality of middle JK flip-flops as is recited in the independent claims 1, 20, 32, and 40. Mano does not show or discuss a Johnson counter. Therefore, even as combined, Li, Epstein, and Mano do not show the claimed invention.

There is also no clear and particular evidence of a suggestion or motivation to combine Li, Epstein, and Mano. The final Office Action stated that:

“[I]t would have been obvious to implement the 5 stages (flip flop circuits) Johnson counter of Li with a five JK flip flop circuit arranged as in Epstein because JK flip flop is

2 MPEP 2143 citing *In re Vaeck*, 20 USPQ2d 1438, 1442 (Fed. Cir. 1991).

3 *In re Lee*, 61 USPQ2d 1430, 1433 (Fed. Cir. 2002).

4 *In re Dembiczak*, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999).

5 Final Office Action dated April 7, 2004, page 2.

6 Mano, page 131.

reliable thus preventing the counter from erroneous operation as taught by Mano."⁷

Epstein does not show a counter with five JK flip flops. Epstein's Johnson counter has only three JK flip-flops. More significantly, Mano does not show or discuss Johnson counters. Mano does not comment on the reliability of any particular Johnson counter, and does not teach that any particular Johnson counter suffers from erroneous operation. One skilled in the art would not be motivated by Mano to modify the Johnson counter of Li.

There is no evidence of the rationale stated in the final Office Action and quoted above for combining Li, Epstein, and Mano as is required by *In re Lee*. There is no showing of clear and particular evidence of a suggestion for combining Li, Epstein, and Mano as is required by *In re Dembicza*.

The final Office Action has also not presented evidence of a reasonable expectation of success of this combination of Li, Epstein, and Mano as is required by the MPEP.

The applicant respectfully submits that a *prima facie* case of obviousness against claims 1-3, 20-24, 26-29, 31-37, 39-45 and 47-48 has not been established in the final Office Action, and that claims 1-3, 20-24, 26-29, 31-37, 39-45 and 47-48 are in condition for allowance.

CONCLUSION

The applicant respectfully submits that all of the pending claims are in condition for allowance, and such action is earnestly solicited. The Examiner is invited to telephone the below-signed attorney at 612-373-6973 to discuss any questions which may remain with respect to the present application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

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Date 26 JULY 2005 By _____

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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this 26 day of July, 2005.

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